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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/394,867	09/13/1999	DAVID A. WILLIAMS	7037-377/IU-	5039

7590 05/06/2005

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INDIANAPOLIS, IN 462045137

EXAMINER
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NGUYEN, DAVE TRONG

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/394,867

Applicant(s)

WILLIAMS, DAVID A.

Examiner

Dave T. Nguyen

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-23,38-43 and 79-83 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-23,38-43 and 79-83 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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Elected claims 11-23, 38-43, 79-83, to which the following grounds of rejection remain and/or are applicable, are pending.

The drawings remain objected in view of the reasons set forth in the PTO-948 attached to the previously sent office action. In order to facilitate the publication of a patent should this application be issued as a US patent, Correction of the drawings before the notice of allowance is suggested.

The terminal disclaimer has been entered and accepted. Thus, the ODP rejection is withdrawn.

*35 USC 102(f)*  
*A person shall be entitled to a patent unless –*  
*(f) he did not himself invent the subject matter sought to be patented.*

Given that inventorship of the '907 patent is "TO ANOTHER" where there are distinct inventive entity with one inventor (David A. Williams) in common, and that the claimed subject matter and the subject matter claimed in the issued patent were not, at the time invention was made, owned by the same person or subject to an obligation of assignment to the same person, a rejection under 35 USC 102(f)/103 is set forth below:

Claims 11-23, 38-43, 79-83 are rejected under 35 USC 102(f)/103 as being unaparentable over the claims 1-14 of US Pat No. 6.033.907.

Both the examined claims and the patent claims are drawn to

A method for obtaining a transduced population of viable mammalian cells by a retrovirus expressing ADA, a composition containing the transduced populations, and a method of enhancing the transduction of retrovirus vectors into hematopoietic cells,

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wherein all of the methods and compositions require the presence of substantially pure fibronectin, substantially pure fibronectin fragments, or a mixture thereof, so as to increase the frequency of transduction of the hematopoietic cells by the retrovirus vector.

Thus, given that both disclosures are identical, that the examined claims are derived from that of the patent claims, which is issued to "AN ANOTHER", the rejection under 35 USC 102(f)/103 is proper. As such, a change of inventorship in this application does lead to a reasonable conclusion that the claimed subject matter is derived from that of the patent claims, where the patent has a distinct inventive entity, as explained above. Note that the cited '907 patent was filed before the filing date of this as-filed application, particularly since this application claims as a continuation of the issued patent.

Applicant's response, dated Jan. 11, 2005, have been considered but is not found persuasive.

In the response dated Jan 11, 2005, Applicants asserts that the presently claim must have been derived from another in accordance with the statutory requirement. Such is essentially the case here. As set forth prior to the stated rejection, given that inventorship of the '907 patent is "TO ANOTHER" where there are distinct inventive entity with one inventor (David A. Williams) in common, and that the claimed subject matter and the subject matter claimed in the issued patent were not, at the time

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invention was made, owned by the same person or subject to an obligation of assignment to the same person, the rejection under 35 USC 102(f)/103 remains proper in the absence of evidence to the contrary.

Further, applicant asserts that priority date must also be assessed in order for the rejection to stand. However, MPEP in chapter 2100 states:

**35 U.S.C. 102(f)** does not require an inquiry into the relative dates of a reference and the application, and therefore may be applicable where subsections (a) and (e) are not available for references having an effective date subsequent to the effective date of the application being examined.

Thus, the priority date is not the issue here and the rejection remains proper.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Dave Nguyen* whose telephone number is **571-272-0731**.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Ram Shukla*, may be reached at **571-272-0735**.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Central Fax number, which is **571-273-8300**.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

**For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.**

Dave Nguyen  
Primary Examiner  
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**DAVE TRONG NGUYEN  
PRIMARY EXAMINER**